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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,544	11/25/2003	Hiroto Sasaki	Q78669	4391

7590

10/14/2004

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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/720,544

Applicant(s)

SASAKI ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 6 and 8-10 is/are rejected.  
7) ☒ Claim(s) 4, 5 and 7 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The indicated allowability of claim 6 is withdrawn in view of the newly discovered reference(s) to Yamada et al. (USPN 5585440). Rejections based on the newly cited reference(s) follow. Although allowability has been withdrawn, new search was necessitated by the amending of claims.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on June 24, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,695,716 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Objections***

Claim 8 is objected to because of the following informalities: In claim 8, line 4 "Group VIIIX" should read –Group VII--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the polybutadiene" in line 2. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Gendreau et al. (USPN 4955613).

Regarding claim 8, Gendreau et al. discloses the a golf ball product (one-piece) having the following:

- a) a rubber composition of 100 parts by weight (See Table 1),
- b) 25 to 45 phr of metal salt of an unsaturated carboxylic acid (See Column 4, lines 18 through 24),
- c) 5 to 25 phr of metal oxide (See column 4, lines 40 through 42),
- d) about 0.2 to about 2.0 phr of peroxide (See Column 4, lines 18 through 39),
- e) 15 to 85 phr of polybutadiene synthesized with a catalyst of rare earth element having above about 40% cis-1, 4 and a Mooney Viscosity of no greater than 50 (See Column 4, lines 43 through 53). Gendreau discloses a second polybutadiene in 15 to 85 phr synthesized with a Group VIII element having a Mooney Viscosity of no greater than 50 (See Column 4, lines 43 through 53). The second polybutadiene inherently has the same molecular weight and solution viscosity of that claimed by the applicant Gendreau discloses the same composition.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. (USPN 5585440).

Regarding claim 1 and 9, Yamada et al. discloses a one piece golf ball formed by vulcanization from a rubber composition composed of 100 parts by weight of rubber base material, 5 to 60 parts by weight of unsaturated carboxylic acid, 5 to 60 parts by weight of metal oxide, and 0.1 to 10 parts by weight of organic peroxide wherein the rubber base material contains 60 to 95% by weight based on the weight of a polybutadiene which is synthesized with a catalyst of rare earth element and contains more than 40% of cis-1,4-linkage and has a Mooney Viscosity no less than 50 (See Abstract and Column 5, lines 39 through 46). Though Yamada et al. disclose some of the ranges having lower values than that claimed by the applicant Yamada et al. meets the upper ranges of that claimed by that applicant. Therefore, one having ordinary skill in the art would have found it obvious to have the amounts of material and Mooney Viscosity of that disclosed by Yamada in order to obtain the processability and workability desired by the user.

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Regarding claim 2, Yamada et al. inherently discloses the molecular weight distribution Mw/Mn of 2.0 to 8.0 being that Yamada et al. discloses the same composition as that in claim 1.

Regarding claims 6 and 10, Yamada et al. discloses the composition containing 1 to 30 parts by weight of organic sulfur compound (See Column 3, lines 47 through 53).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. (USPN 5585440) further in view of Sone et al. (USPN 6642314).

Yamada et al. discloses the use of neodymium as a rare earth element, however, the use of a terminal modifier is not disclosed (See Column 3, lines 51 through 59 of Yamada et al.). Sone et al. discloses a rubber composition wherein a terminal modifier is reacted with the rubber composition after polymerization to increase the workability of the composition (See Column 3, lines 36 through 58). One having ordinary skill in the art would have found it obvious to react the rubber composition taught by Yamada et al., with a terminal modifier, as taught by Sone et al., in order to further improve the workability of the composition.

#### ***Allowable Subject Matter***

Claims 4, 5, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

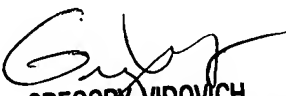
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH  
Alvin A. Hunter, Jr.

  
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